

*Docket No.: 1242.002.1***REMARKS**

Reconsideration of the application is requested in view of the remarks below. Claims 1-12 are pending.

Rejections Under § 102:

Claims 1-5 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Li (U.S. Patent No. 5,575,805). In particular, Li is alleged to disclose all of the features of claim 1.

Claim 1 of the present application recites, *inter alia*, an endoscopic grasping tool surgical instrument having arms which are urged together so that they meet at the wrists while the jaws remain open and the jaws then being urged together so that they meet first at their distal tips and last at their heels.

Li discloses a surgical grasper having jaws 210 which may be closed to allow the jaws to be inserted through a cannula into a patient's body via a suitable incision as described in column 6 of this reference. When the grasper is clear of the cannula the jaws may be opened parallel to one another. The jaws may grasp an object by having their tips moved toward one another to grasp tissue therebetween as depicted in FIG. 8 and described in column 6. The proximal portions of the jaws remain separated from one another when the jaws grasp the tissue, as described in the first paragraph of column 7. However, there is no disclosure in Li of a pair of clamping arms of an endoscopic grasping tool surgical instrument which are urged together so they meet at their wrists while the jaws remain open. Further, there is no disclosure of the jaws being urged together so they meet first at their tips and last at their heels.

As described above, the proximal ends of jaws 210 in Li do not meet during the grasping process. Thus, even if such proximal ends were considered to be heels they would not meet at all during the grasping process. Further, there is no indication that when the jaws are closed such that they are parallel to one another that they would meet first at their distal tips and then at their heels. Moreover, there is no indication of what the Office Action considers to be wrists of the arms, nor is there any indication of a portion of clamping arms which could be considered to be wrists that meet while jaws thereof remain open. In particular, page 11 of the present application describes the wrist being located where a clamping arm begins to diverge distally from a second clamping arm. From a review of the specification and drawings of Li, there does not appear to be clamping arms disclosed therein. Even if shaft 420 was considered to be clamping arms and the forward end 420 thereof was considered to be a wrist, there is no disclosure of such wrists meeting each other, let alone such wrists meeting each other while the jaws remain open. Accordingly, because the features of claim 1 (e.g., arms which meet at their wrists while the jaws remain

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open, and jaws which meet first at their tips and then at their heels) are not identically disclosed by Li, it is respectfully submitted that claim 1 cannot be anticipated by this reference. Claim 1 is therefore believed to be allowable. The dependent claims are believed to be allowable for the same reasons and for their own additional features.

Claim 6 stands rejected under 35 U.S.C. § 102(b) as being anticipated by Lichtman (U.S. Patent No. 5,620,459). Claim 6 recites, *inter alia*, a method of ratcheting the closure of a pair of jaws of an endoscopic grasping tool surgical instrument which includes providing a handle having a drive head which moves distally to affect jaw closure and the drive head having teeth formed thereon. Also, a pawl is provided which is positioned for engagement with the teeth so as to prevent proximal movement of the drive head after it has moved distally.

Lichtman discloses a surgical instrument including a handle 14 having gear teeth 38 thereon which engage gear rack teeth 40 of a gear rack 236 as depicted in FIG. 9, for example. By moving handle 14 about a pivot pin 18, gear teeth 38 engage with gear rack teeth 40 and cause movement of gear rack 36 to cause movement of outer tube 8 which may envelope jaws 4 and 6 to cause closure thereof, as described in column 7. Also, sleeve 36 may include teeth 71 on a top portion thereof which are engaged by a pawl 73 to obstruct rearward movement of gear rack 236. However, there is no disclosure in this reference of a handle which has a drive head which includes teeth formed thereon engagable with a pawl to prevent proximal movement of the drive head after it has moved distally. Instead, Lichtman discloses a pawl engagable with a tube that is separately engagable with teeth of a handle, but the handle itself does not have teeth thereon which are engagable with a pawl. Further, the teeth on the handle in Lichtman are engagable with teeth of a gear rack or sleeve and the pawl is engagable with the top portion of the gear rack tube that has teeth thereon, but there is no disclosure of teeth on a drive head engagable with a pawl to prevent proximal movement of a drive head after it is moved distally. Accordingly, because the features of claim 6 of the present application (e.g., a drive head having teeth formed thereon engagable with a pawl to prevent proximal movement of the drive head) are not identically disclosed by Lichtman, claim 6 cannot be anticipated by this reference. Thus, claim 6 is believed to be allowable along with the dependent claims, which are believed to be allowable for the same reasons and for their own additional features.

Rejections Under § 103:

Claims 8-11 stand rejected under 35 U.S.C. § 103(a) as being obvious over Stern et al. (U.S. Patent No. 5,443,463) in view of Yoon (U.S. Patent No. 5,665,100). Specifically, Stern et al. is alleged to disclose all the features of claim 8 except for providing a handle having a drive head operable between a jaws open position and a jaws closed position, providing a drive rod having a distal end operatively

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coupled to a cutter and a proximal end in the handle, providing a drive plate operatively coupled to the distal end of the drive rod, moving the cutter to a cutter advanced position by moving the drive plate, and blocking movement of the cutter to the cutter advanced position by the drive head when the drive head is not in the jaws closed position. Yoon is alleged to disclose the features not disclosed by Stern et al.

Claim 8 recites, *inter alia*, providing two pairs of clamping arms, a handle having a drive head operable between a jaws open position and a jaws closed position, a drive rod having a distal end operatively coupled to the cutter and a proximal end in the handle, and a drive plate operatively coupled to the distal end of the drive rod. Further, a cutter is moved from a cutter advanced position by moving the drive plate and movement of the cutter is blocked from the cutter advanced position by the drive head, when the drive head is not in the jaws closed position.

Stern et al. discloses an apparatus for selectively coagulating blood vessels or tissue which includes a cutting blade which slides between two upper jaws located above a lower jaw. However, this reference does not disclose two pairs of clamping arms as recited in claim 8, but instead discloses a pair of forceps having a pair of jaws one atop the other or even a pair of bifurcated jaws (see FIG. 2A) with each jaw connected to an arm of the forceps, but there is no disclosure of such jaws being connected to two pairs of clamping arms. Further, as described in the Office Action, there is no disclosure in Stern et al. of a handle having a drive head operable between a jaws open position and a jaws closed position, providing a drive rod having a distal end operatively coupled to the cutter and a proximal end in the handle, providing a drive plate operatively coupled to the distal end of the drive rod, moving the cutter to a cutter advanced position by moving the drive plate, and blocking movement of the cutter to the cutter advanced position by the drive head when the drive head is not in the jaws closed position.

Yoon discloses an endoscopic instrument having a set of jaws which are moveable by a user manipulating handles 110 and 104. Specifically, by moving the handles apart jaws 18 and 20 are opened by the handles causing movement of an inner and outer tube relative to one another such that the jaws are closed as they are pulled toward the outer tube by movement of the handle, as depicted in FIG. 14. A safety mechanism 36 is depressed to allow a cutter blade to be advanced by movement of a moving handle 90. However, there is no disclosure of a drive plate which moves a cutter to a cutter advanced position nor blocking movement of the cutter to such cutter advanced position by the drive head when the drive head is not in the jaws closed position as recited in claim 8. Instead, movement of the cutter may be blocked by utilizing safety mechanism 36 which may lock inner member 22 in a retracted position such that blade 76 carried by the inner member cannot be inadvertently advanced toward the jaws, as described in column 9. The safety mechanism includes a pin which may block movement of a flange 94 thereby

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blocking movement of tubular member 22, but the safety mechanism is not a drive plate, nor is it a drive head which blocks movement of a cutter when it is in a jaws closed position. In contrast, a drive plate recited in claim 8 moves the cutter and a drive head blocks movement of the cutter when the drive head is not in the jaws closed position. Accordingly, because all the features alleged to be disclosed by Stern et al. and Yoon (e.g., moving a cutter to a cutter advanced position by moving a drive plate, blocking movement of the cutter to a cutter advanced position by a drive head, and two pairs of clamping arms) are not in fact disclosed by these references or their combination, such a combination of these references cannot make claim 8 of the present application obvious.

Further, there is no suggestion or motivation to combine the Stern et al. and Yoon references. The Office Action alleges that it would have been obvious for one skilled in the art to combine the safety mechanism disclosed by Yoon in the Stern et al. apparatus. However, there is no indication in the Office Action of how these two references could be combined. More specifically, one reference discloses an endoscopic tool which involves the movement of interior tubes relative to one another, while the other involves a pair of forceps having a pair of jaws and a cutting blade, but any combination thereof would make one or the other unsatisfactory for its intended purpose, thereby invalidating any reason to combine them. Moreover, these references are in different fields since Yoon relates to a device capable of operating through an incision in the body while the forceps disclosed in Stern et al. are not capable of being used through such an incision. Thus, it is respectfully submitted that it is only through impermissible hindsight reasoning that these references have been combined to allegedly make this claim obvious. Accordingly, there would be no reason to combine these references and, even if they were combined, they would not result in the subject matter of claim 8. Further, the dependent claims are believed not to be obvious for the same reasons and for their own additional features.

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CONCLUSION

It is believed that the application is in condition for allowance, and such action is respectfully requested.

If a telephone conference would be of assistance in advancing prosecution of the subject application, Applicant's undersigned attorney invites the Examiner to telephone him at the number provided.

Respectfully submitted,

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Dated: May 12, 2004

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